

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

1, 2, 4-12 and 14-20 are all the claims pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

Claims 17-20 are hereby added, and as claims 3 and 13 are hereby cancelled without prejudice or disclaimer. Claims 1, 2 and 4-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toy et al. (U.S. Pat. No. 6,192,115; hereinafter “Toy”) in view of Okoro et al. (U.S. Pat. No. 6,754,490; hereinafter “Okoro”). Claims 9, 10 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toy in view of Okoro in further view of Dunn et al. (U.S. Pat. No. 6,138,008; hereinafter “Dunn”). Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toy in view of Okoro in further view of Asano et al. (U.S. Pat. No. 5,991,721; hereinafter “Asano”). Applicant respectfully traverses these claim rejections.

Independent claim 1 incorporates the subject matter of original claims 3 and 13. Claim 1 now recites, in part:

a location obtaining unit that obtains location of said mobile station;

a visitor registration unit that registers said mobile station as a visitor station in said second country to have said mobile station capable of establishing a connection via a second network in said second country when said mobile station moves to said second country and requests for the registration;

a reporting unit that reports said registration of said mobile station to said location obtaining unit; and

a retaining unit that temporarily retains establishing a connection between said caller terminal and said mobile station, wherein said location obtaining unit stores information about said registration of said mobile station in said information storing unit.

Therefore, claim 1 requires, *inter alia*, that a visitor registration unit register the mobile station as a visitor station in the second country so that the mobile station is capable of establishing a connection via a second network in the second country when the mobile station moves to the second country and requests registration, and further, a retaining unit that temporarily retains establishing a connection between said caller terminal and said mobile station.

With regard to original claim 3, the Examiner asserts that Toy discloses these features at col. 2, lines 16-26. However, Applicant notes that Toy merely discloses providing “a called party’s name and/or location.” See Toy, col. 2, lines 16-17. In other words, Toy fails to teach or suggest a visitor registration unit that registers the mobile station as a visitor station in the second country so that the mobile station is capable of establishing a connection via a second network in the second country when the mobile station moves to the second country and requests registration. Consequently, Applicant submits that Toy fails to teach or suggest all of the features required by claim 1.

Further, Okoro fails to teach the claimed elements missing from Toy. The Examiner asserts that “Okoro teaches international roaming services.” However, Okoro fails to disclose the claimed feature of a visitor registration unit which registers the mobile station as a visitor station in a second country. Therefore, neither of the applied references teach or suggest all of the features set forth by claim 1.

With regard to the claimed feature of a retaining unit that temporarily retains establishing a connection between said caller terminal and said mobile station, the Examiner initially asserts:

Toy in view of Okoro does hint but may be unclear about a notification system ... comprising a retaining unit that temporary retains establishing a connection between said caller and said mobile station.

However, a “hint,” especially an “unclear” one, does not qualify as a teaching or a suggestion. Nevertheless, the Examiner asserts that Dunn clearly discloses this feature, and that it would be obvious to one of ordinary skill in the art at the time of the invention “to retain connection while the user select options for the call so the user does not have to terminate the call and enter a series of numbers.” Applicant respectfully disagrees with the Examiner’s position.

Assuming, *arguendo*, that the references do teach all of the claimed features, there is nothing in any of the applied references that teaches or suggests the unique combination of features required by claim 1. Moreover, the applied references, taken alone or in combination do not render the claimed invention obvious. It is well settled that the proper inquiry for obviousness is what the reference as a whole teaches or suggests to those of ordinary skill in the art. It is also well settled that one cannot pick and choose among the features disclosed or taught by the prior art in determining obviousness. Applicants submit that such conclusions could be based only impermissible hindsight in construing the references as he has to yield the present invention.

Furthermore, since claims 2-8 depend on claim 1, and since, as noted above, Applicant submits that Toy fails to disclose all of the required features of claims 2-8, at least by virtue of

their dependency on claim 1. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 2-8.

Additionally, regarding the Examiner's rejection of claims 9 and 10 as allegedly being unpatentable over Toy in view of Okoro et al. (U.S. Pat. No. 6,754,490; hereinafter "Okoro") and in further view of Dunn et al. (U.S. Pat. No. 6,138,008; hereinafter "Dunn"), Applicant submits that neither Okoro nor Dunn cure the deficiency of Toy, as noted above.

Likewise, regarding the Examiner's rejection of claims 11 and 12 as allegedly being unpatentable over Toy in view of Okoro in further view of Asano et al. (U.S. Pat. No. 5,991,721; hereinafter "Asano"), Applicant submits that neither Okoro nor Asano cure the deficiency of Toy, noted above.

Similarly, regarding the Examiner's rejection of claims 13-16 as allegedly being unpatentable over Toy in view of Okoro and in further view of Dunn, Applicant submits that neither Okoro nor Dunn cure the deficiency of Toy, as noted above.

Therefore, Applicant submits that claims 9-16 are patentable over the applied references, at least by virtue of their dependency on claim 1. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 9-16 for the reasons stated above.

Finally, Applicant submits that new claims 17-20 are patentable over the applied references, for reasons at least analogous to those stated above.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.114 (c)
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

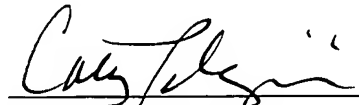
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